

Application Serial No. 10/678,190
Reply to Office Action dated July 5, 2006

AUG 04 2006**REMARKS/ARGUMENTS**

The outstanding Office Action sets forth a three-way restriction in the above-identified application. As filed, the application contains 21 claims, of which claims 1-16 are product claims and claims 17-21 are method claims. The application was specifically drafted with claims 2-9 being directed to a vending machine and, more particularly, to particulars of a bail cap attached to an oscillator in a vending machine, and claims 10-16 being directed to a vending machine and, more particularly, to the details of the oscillator. Claim 1 was drafted as a combination claim including all the particulars of the sub-combination claims 2 and 10.

With the above in mind, the Applicant respectfully traverses the restriction requirements between claims 1-16. More specifically, it is respectfully submitted that claim 1 links the independent sub-combination claims 2 and 10 such that restriction is improper. In particular, it is respectfully submitted that neither independent claim 2 nor independent claim 10 can be properly restricted from combination claim 1.

In making the restriction requirement, the Examiner incorrectly relies upon M.P.E.P. § 806.05(d). This section clearly specifies that restriction is only proper when two or more claimed sub-combinations, which are only disclosed as usable together in a single combination, do not overlap in scope and can be shown to be separately usable. The M.P.E.P. clearly states that when these factors are not shown, the inventions are not distinct such that restriction is not proper.

Initially, it should be noted that the present case contains two claimed sub-combinations, claimed as usable together. As the combination is claimed and not simply disclosed in the specification, § 806.05 (d) does not apply. However, even if, *arguendo*, § 806.05(d) did apply, the Examiner has still failed to set forth a proper restriction. M.P.E.P. § 806.05(d) states that restriction is proper only if the subject matter of the claimed sub-combinations does not overlap. In contrast, each of claims 1-16 is directed to a vending machine. Sub-combination claims 2-9 and 10-16 require several structural

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limitations in common, e.g., a cabinet frame, a plurality of column walls that define stack areas and a door, all of which define, at least in part, a vending machine. Note that all of these limitations are also present in claim 1. Thus, the Applicant respectfully submits that the sub-combination claims clearly overlap in scope and the combination is not simply disclosed in the specification but recited in claim 1 such that restriction under § 806.05(d) is improper. It is also interesting to note that the restriction requirement presented between the combination and sub-combination claims was not made utilizing the form paragraph for combination/sub-combination restrictions outlined in § 806.05(d). This form paragraph specifically recites the criteria for distinctiveness and, as set forth above, specifically requires that the sub-combination claims to not overlap in scope and not be obvious variants.

As stated above, the Examiner has relied upon the wrong section of the M.P.E.P. in setting forth his restriction requirement. M.P.E.P. § 806.05(d) is applicable only when the sub-combination claims are disclosed as usable together, not claimed as usable together as is the case in the present application. In the event that the combination is claimed, M.P.E.P. § 806.05(c) describes the circumstances under which a restriction between combination/sub-combination claims is proper. This section clearly specifies that supporting a requirement for restriction under combination/sub-combination requires two-way distinctiveness. That is, the inventions can be shown to be distinct if and only if: a) the combination as claimed does not require the particulars of the sub-combination; and b) the sub-combination can be shown to have utility either by itself or in other and different relations. The M.P.E.P. clearly states that only when both of these factors are shown is a restriction proper.

In the present case, the Applicant would admit that the sub-combinations can have separate utility. However, combination claim 1 requires all the particulars of each independent sub-combination claim 2 and 10 such that claim 1 cannot be properly restricted from either of these claims. Specifically, combination claim 1 contains word-for-word, each of the limitations of claims 2 and 10. No where in the restriction requirement does the Examiner address this issue. In view of the above, it is respectfully

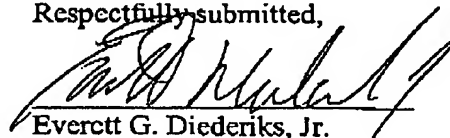
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submitted that the Office Action does not set forth a proper restriction between claims 1-9 and claims 10-16. Instead, these restrictions cannot be properly made such that withdrawal of this grouping is respectfully requested.

With withdrawal of this aspect of the restriction requirement, the Applicant would elect for initial prosecution product claims 1-16. It is also submitted that it would not be unduly burdensome on the Examiner to also review method claims 17-21. However, if the Examiner continues to hold the restriction of claims 17-21, the Applicant would elect, without traverse, the product claims, i.e. claims 1-16 for initial prosecution, while reserving the right to file a divisional application at a later time on the method claims.

Even though the restriction between claims 1-16 is seen to be clearly improper, the Office Action requires the Applicant to still elect one of the identified groups. Therefore, in order to fully reply, the Applicant elects, with traverse, claims 1-9 for initial prosecution in this case. Again, it is respectfully submitted that claims 10-16 cannot be properly restricted from claims 1-9. If any type of restriction between the product claims is to be set forth in this application, it is respectfully requested that the Examiner provide further justification for the restriction including a basis for restricting claims 10-16 from claim 1, as claim 1 clearly requires all the particulars of claim 10. If the Examiner does not intend to withdraw this restriction requirement, he is cordially requested to contact the undersigned as soon as possible to allow the timely filing of a Petition on this matter.

Respectfully submitted,



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